

REMARKS

The Examiner has objected to the specification. Such objections have been avoided by virtue of the amendments to the specification made hereinabove.

The Examiner has objected to the claims. Such objections have been avoided by virtue of the clarifications made hereinabove to the claims.

The Examiner has further rejected Claim 23 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards the invention. Such rejection has been avoided by virtue of the clarifications made hereinabove to the claims.

The Examiner has rejected Claim 8 under 35 U.S.C. 103(a) as being unpatentable over Moses et al., in view of Kennedy. The Examiner has further rejected Claim 8 under 35 U.S.C. 103(a) as being unpatentable over Moses et al., in view of Ralston, and in further view of Kennedy. Applicant respectfully disagrees with such rejections, especially in view of the amendments made hereinabove.

With respect to pending Claims 8 and 18, the Examiner has admitted that Moses fails to disclose, teach or suggest applicant's claimed "negotiating a contract with the user regarding the type of change the second module notifies the user of, for negotiating the way the second module notifies the user, for negotiating the diligence used for notifying the user of the change in condition, and for negotiating a price for notifying the user." The Examiner further relies, in part, on Kennedy, and, in part, on Official Notice to make a prior art showing of the foregoing limitations.

Regarding the Official Notice, applicant formally requests a specific showing of ALL of the subject matter in such claims in any future action. Note excerpt from MPEP below.

"If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position." See MPEP 2144.03.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991). Applicant respectfully asserts that at least the first and third elements of the *prima facie* case of obviousness have not been met.

With respect to the first element, the Examiner argues that it would have been obvious to modify Moses in view of the teachings of Kennedy by combining the step of negotiating with the teachings of Moses. Applicant respectfully disagrees. Moses merely teaches one way of notifying the user of certificate changes, only one type of diligence, etc. Since there are no optional choices, etc. and/or mechanism for choosing therebetween, it would be *impossible* to negotiate in the manner suggested by Kennedy. Kennedy clearly *teaches away* from Moses in this regard. To attempt to combine such non-analogous references in the Examiner's proposed manner in order to render applicant's improvement in the art of electronic certificate monitoring services would improperly frustrate the inventive concepts of applicant. Thus, the first element of the *prima facie* case of obviousness has clearly not been met.

With respect to the third element, applicant notes that simply nowhere in the prior art is there any "negotiating a contract with the user regarding the type of change the second module notifies the user of, for negotiating the way the second module notifies the user, for negotiating the diligence used for notifying the user of the change in condition, and for negotiating a price for notifying the user." Since none of the references teach or suggest such specific combination of features, the third element of the *prima facie* case of obviousness has not been met.

To emphasize the foregoing distinction, applicant has added new Claim 25, which requires “a third module in the computer program for negotiating a contract with the user regarding which of a plurality of types of changes the second module notifies the user of, for negotiating which of a plurality of ways the second module notifies the user, for negotiating which of a plurality of diligences used for notifying the user of the change in condition, and for negotiating which of a plurality of prices for notifying the user” (emphasis added).

To further expedite the prosecution of the present application, applicant has amended each of the independent claims to include subject matter similar, but not identical, to that of Claims 8 and 18.

Applicant emphasizes that simply nowhere in the prior art is there any “graphical user interface [that] is utilized to allow the user to negotiate among a plurality of choices regarding electronic certificate monitoring service contract terms, the terms selected from the group consisting of: the way of notifying the user, and the diligence with which the user is notified of the change in condition,” as now independently claimed.

Only applicant teaches and claims such a particular negotiation graphical user interface specifically in the context of an electronic certificate monitoring service system.

Applicant has further emphasized this distinction in new Claims 24 and 26 by claiming:

“the graphical user interface includes a plurality of drop down menus each associated with one of the terms for allowing the user to select among the choices relating to the associated term”

A specific prior art showing of each of the foregoing claim limitations, or a notice of allowance is respectfully requested.

All of the independent claims are thus deemed allowable. Moreover, by virtue of their dependence on the independent claims all of the dependent claims are also deemed allowable.

A notice of allowance is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P068).

Respectfully submitted,

  
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